APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/740,489	12/22/2003	M. Charlotte Baltus	117428	2063

			EXAMINER
27074	7590	12/12/2006	TSUI, WILSON W

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ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/740,489	BALTUS ET AL.
	Examiner	Art Unit	
	Wilson Tsui	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 September 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-7,10-12 and 14-16* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-7,10-12 and 14-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the Request for Continued Examination filed on:
09/27/06.

2.   Claims 1, 3, 4, 5, 7, and 12 have been amended. Claims 2, 8-9, and 13 have
been cancelled. Claims 1, 3-7, 10-12, and 14-16 are pending.

3.   Acknowledgment has been made to the amendments to claim 7 (for correcting
the spelling of the word "by"), thus, the objection to claim 7 due to informalities, has
been withdrawn.

4.   Acknowledgement has been made to the amendments to claims 1 and 12 (for
correcting the lack of antecedent basis for the feature "the selecting document"), thus,
the 35 USC 112 rejections for claims 1 and 12 have been withdrawn.

EXAMINER'S AMENDMENT

5.   An examiner's amendment to the record appears below. Should the changes
and/or additions be unacceptable to applicant, an amendment may be filed as provided
by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be
submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in the interview with
James Golladay on September 12, 2006.

The Information Disclosure Statement filed 04/18/2006 has been amended as
follows:

Replace the first IDS entry marked with a Document Number: "2002/002567 A1",
with the Document Number of "2002/0002567 A1".

Replace the second IDS entry marked with a Document Number "2003/005041

A1", with the Document Number of "2003/0005041 A1".

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

6.   Claims 7, 12, and 16 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

With regards to claim 7, the claimed "apparatus" is directed to a "computer program per

se" without hardware. Since the computer program is not embodied in a computer

readable medium, it is thus, not statutory.

See MPEP 2106 below:

Data structures not claimed as embodied in computer-readable media are descriptive
material per se and are not statutory because they are not capable of causing functional
change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760
(claim to a data structure per se held non statutory). Such claimed data structures do
not define any structural and functional interrelationships between the data structure
and other claimed aspects of the invention, which permit the data structure's
functionality to be realized. In contrast, a claimed computer-readable medium encoded
with a data structure defines structural and functional interrelationships between the
data structure and the computer software and hardware components which permit the
data structure's functionality to be realized, and thus statutory.

With regards to claims 12, the claimed "system" is directed to a "computer program per

se" without hardware. Since the computer program is not embodied in a computer

readable medium, it is thus, not statutory. See MPEP 2106 (as shown above).

With regards to claim 16, which depends on rejected claim 12, and does not resolve the

statutory rejection for claim 12, is rejected under similar rationale.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.   Claims 1, 3, 6, 10, 12, 14, and 16 are rejected under 35 U.S.C. 102(b) as being

anticipated by Ball et al (US Application: 2002/0120648 A1, published: Aug. 29, 2002,

filed: Feb. 15, 2002).

With regards to claim 1, Ball et al teaches a method for highlighting changes in an

information object comprising:

- *Identifying a user.* Referring to Figure 5, it is shown that each user is identified

   such that hot list items are linked to each user. Ball et al further elaborates upon

   this detail by saying that "the invention maintains a table ... (along with) ... a list

   of pages or documents, owned by each user (paragraph 0086)". Thus, for a

   document-to-user mapping be possible, it is inherent that each user has been

   identified. For resource optimization, the user is identified as well, as explained

   in paragraph 0168.

- *Receiving a request from the user for a selected version of an information object.*

   (paragraph 0059: whereas, the external service receives the web page selection

   request from a user for a current version of a web page 'A'. Additionally, it is

   taught that the user can enter a snapshot program, specifying an information

   object, for one or more selected versions of an information object Fig 3A.)

- *In response to the request for the information object, obtaining a most recent version of the information object as the selected version of the information object requested by the user* (paragraph 0059: whereas, the external service retrieves the most recent version of the information object requested by the user that is available from the storage of the external service (also described in paragraphs 0055, 0106), and shown in Fig 3A.).

- *Obtaining a previous version of the information object based on a result of identifying the user* (Previous version(s) of the page(s) requested by the identified user are stored together with subsequent changes as indicated in Fig 3, reference number 6 (paragraph 0055). Additionally, one or more previous versions of the information object is/are obtained as shown in Fig 3A, based upon the snapshot request for an information object. The previous versions obtained for display in Fig 3A, include *the previous version of the information object being a version of the information object most recently accessed by the user*, as explained in paragraphs 0055-0059).

- *Automatically determining a difference between the selected version of the information object and the previous version of the information object:* (in response to the request for the information object, the snapshot facility provides a means for automatically determining the difference between the selected version of the information object, and the previous version of the information object (paragraph 0195, Fig 3A: whereas, in response to the request for the information object, the snapshot facility displays a screen, which allows the user

to automatically determine the difference between the selected version of the

information object, and previous version of the information object using the

automatic differencing program 'htmldiff'.

- *Automatically outputting a rendered version of the information object highlighting*

  the difference: The output from the 'htmldiff' program is automatically outputted to

  a display as a rendered version of the information object, highlighting the

  difference, as explained in paragraph 0059 (whereas, the output of the rendered

  version is shown in the figure 4 screen shot) such that the image "represents

  changes, and contains material not present in the previous version of the page,

  but which has been added (paragraph 0061)". To highlight the changes, a

  "particular font, particular size, particular color, and particular background

  (paragraph 0061)" may be used)).

With regards to claim 3, which is dependent on claim 1, Ball et al. teaches a method

further comprises, *displaying the rendered version of the information*: The rendered

version of the information is rendered for display in a browser application (Figure 4:

whereas, changes are highlighted/marked in the document (in this case, highlights

include italics, cross-outs, asterisks, and more) that were selected for access by the

user and displayed in a browser application as shown in the screen shot)

With regards to claim 6, which is dependent on claim 1, Ball et al teaches *wherein*

the most recent version of the information object, as explained in the rejection for claim

1, and is rejected under the same rationale. Furthermore, Ball et al also teaches *the*

most recent version of the information object that the user is authorized to access

(paragraph 0170: whereas, a system is used to authorize users, before information is

sent to each user. Furthermore, as discussed in paragraph 0086, each hotlist (list of

information items) are managed/authorized for each particular user).

With respect to claim 10, which is dependent on claim 7, Ball et al teaches:

At least one database that stores the current version and the previous version (Ball

et al, paragraph 0130: whereas, an application called NO HANDS, is used by the

external service to help provide users with a way to organize, retrieve, and view

differences between pages. Since NO HANDS provides for a collection of information

organized in such a way to aid users or a computer program to more efficiently select

pieces of data; NO HANDS implements a database). Furthermore, NO HANDS is used

to help present the differences between the current and previous versions that are

stored in the external service. (paragraph 0131: through one of NO HANDS' tools called

Htmldiff).

An output device that outputs the rendered version: Ball et al inherently teaches that

an output device is used to output a rendered version as a screen shot of the rendered

version is provided for in Figure 4. Thus, for a user to see the output shown in Figure 4,

an output device has been used to output the rendered version.

With regards to claim 12, for a system performing a similar method as the method of

claim 1, is rejected under the same rationale.

With regards to claim 14, which is dependent on claim 12, for *outputting the*

rendered version to the display device: Ball et al. inherently teaches that an output

device is used to output a rendered version as a screen shot of the rendered version is

provided for in Figure 4. Thus, for a user to see the output shown in Figure 4, an output

device has been used to output the rendered version.

With regards to claim 16, which is dependent on claim 12, for a system performing a

method similar to the method of claim 6, is rejected under the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 4, 11, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Ball et al (US Application: 2002/0120648 A1, published: Aug. 29, 2002, filed: Feb.

15, 2002).

With regards to claim 4, which is dependent on claim 1, Ball et al. teaches the

use of an application named HTMLDIFF, which is used to reconstruct the selected

document/page such that changes between two versions are marked/highlighted to

produce a final output in a HTML document (paragraph 0059, figure 4: whereas, the

output is shown through the use of an web browser). Ball et al. however, does not

expressly teach *printing the rendered version of the information object on a printing*

device. Nevertheless, printing images displayed on a computer screen, such as web

pages accessed by a browser, is notoriously well known in the art. The Examiner takes

OFFICIAL NOTICE of this teaching.

It would have thus been obvious to one of the ordinary skill in the art at the time

of the invention to have modified the system taught by Ball et al. such that any web

pages comprising of the document content and highlighted changes may be printed, as

is known in the art. It would have been advantageous to utilize this combination

because a printed copy of a web page is useful, for example, to view or present the web

page at a later time when not near a computer or to function as a hardcopy/backup

resource.

With regards to claim 11, which is dependent on claim 10, Ball et al. teaches the

use of an application named HTMLDIFF, which is used to reconstruct the selected

document/page such that changes between two versions are marked/highlighted to

produce a final output in a HTML document (paragraph 0059, figure 4: whereas, the

output is presented through the use of a web browser). Therefore, Ball et al. inherently

teaches *a display is used as an output device* in order for the user to view the screen

shot of figure 4. Ball et al. however, does not expressly teach *printing the rendered*

version of the information object on a printing device. Nevertheless, printing images

displayed on a computer screen, such as web pages accessed by a browser, is

notoriously well known in the art. The Examiner takes OFFICIAL NOTICE of this

teaching.

It would have thus been obvious to one of the ordinary skill in the art at the time

of the invention to have modified the system taught by Ball et al. such that any web

pages comprising of the document content and highlighted changes may be printed, as

is known in the art. It would have been advantageous to utilize this combination

because a printed copy of a web page is useful, for example, to view or present the web page at a later time when not near a computer or to function as a hardcopy/backup resource.

With regards to claim 15, which is dependent on claim 12, for *outputting the rendered version to a printing device*: Ball et al. teaches the use of an application named HTMLDIFF, which is used to reconstruct the selected document/page such that changes between two versions are marked/highlighted to produce a final output in a HTML document (paragraph 0059, figure 4: whereas, the output is presented through the use of a web browser). Ball et al. however, does not expressly teach *printing the rendered version of the information object on a printing device*. Nevertheless, printing images displayed on a computer screen, such as web pages accessed by a browser, is notoriously well known in the art. The Examiner takes OFFICIAL NOTICE of this teaching.

It would have thus been obvious to one of the ordinary skill in the art at the time of the invention to have modified the system taught by Ball et al. such that any web pages comprising of the document content and highlighted changes may be printed, as is known in the art. It would have been advantageous to utilize this combination because a printed copy of a web page is useful, for example, to view or present the web page at a later time when not near a computer or to function as a hardcopy/backup resource.

9.   Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ball et al (US Application: 2002/0120648 A1, published: Aug. 29, 2002, filed: Feb. 15, 2002) in

further view of Warmus et al (US Patent Number: 6,952,801 B2, issued: Oct. 4, 2005,

filed: May 10, 2001).

With respect to claim 5, which is dependent on claim 1, Ball et al. does not teach

encoding information on the stored information in glyphs such that the encoded

information designates the version of the information object.

Warmus et al. however, teaches *encoding information on the stored information*

in glyphs such that the encoded information designates the version of the information

object (Warmus et al., column 3, lines 60-62: whereas, "the step of specifying page

description language instructions to produce a barcode on the page. The barcode may

be indicative of tracking information").

Furthermore, Ball et al and Warmus et al. are from the same problem solving

area: Document processing.

It would have been obvious to one of the ordinary skill in the art at the time of the

invention to have modified Ball et al's storage of page content to further include

metadata for the creation of a barcode to identify the information object's version as

taught by Warmus et al. The combination of Ball et al, and Warmus et al. would have

allowed Ball et al's version tracking system to be used outside of electronic form so

users would have been able to identify and differentiate between different versions of

hardcopies.

10.   Claims 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ball et

al (US Application: 2002/0120648 A1, published: Aug. 29, 2002, filed: Feb. 15, 2002) in

further view of Jeffery et al. (US Patent Number: 6,957,384 B2, Issued: Oct. 18, 2005,

filed: Dec. 27, 2000).

With regards to claim 7, Ball et al. teaches an apparatus that highlights changes in an

information object comprising:

- *A processor that, in response to the request, retrieves a most recent version*

   of the information object as the selected information object, and a previous

   version of the information object, the previous version being obtained based

   on the identification of the user and being a version of the information object

   most recently accessed by the user, as similarly explained in the rejection for

   the method of claim 1, and is rejected under the same rationale.

- *A delta determination device that, in response to the request, automatically*

   determines a difference between the selected version and the previous

   version, as similarly explained in the rejection for the method of claim 1, and

   is rejected under the same rationale.

- *A renderer that, in response to the request, automatically generates a*

   rendered version of the information object highlighting the difference, as

   similarly explained in the rejection for the method of claim 1, and is rejected

   under the same rationale.

In addition, Ball et al's external service teaches *identifying a user* as by referring

to Figure 5, it is shown that each user is identified such that hot list items are linked to

each user. Ball et al further elaborates upon this detail by saying that "the invention

maintains a table ... (along with) ... a list of pages or documents, owned by each user

(paragraph 0086)". Thus, for a document-to-user mapping be possible, it is inherent that

each user has been identified. Furthermore, Ball et al teaches *a request for retrieving a*

selected information object, as similarly explained in the rejection for the method of

claim 1, and is rejected under the same rationale. Yet, Ball et al does not expressly

teach *a query interface that receives a user identification and request for a selected*

information object.

Jeffery et al however, teaches *a query interface that receives user identification*

(Figure 24: whereas, an interface is shown and a form is used to query the user for a

login ID) *and request data for a selected information object* (Figure 7-1, column 10, lines

2-5: whereas, an interface is shown such that a user is able to click on (select) a

specific contract number to request data for that particular contract/information object

and "contracts may be displayed and accessed").

It would have been obvious for one of the ordinary skill in the art at the time of

the invention to have modified Ball et al's user identification routine to further include the

query interface for user identification and information object data request as taught by

Jeffery et al. The combination of Ball et al and Jeffery et al, would have helped Ball et

al's invention to "provide a method for storing, organizing and providing remote

electronic access to documents" (Jeffery et al, column 2, lines 24-26).

Response to Arguments

11.   With respect to claim 1, the applicant first argues that "Ball may not reflect a most

recently-current version of the document". However, "the most recent version" of an

information object is broad with respect to the source of where the most recent version

is located. Since the claim language does not require the source/origin/location of where

the most recent information is stored, the applicant's argument is thus not persuasive

since Ball et al's invention retrieves "the most recent version" of an information object

with respect to versions of the information object available from an external service (as

explained in the rejection for claim 1 above).

12.   With respect to the applicant's argument that claims 7, and 12, are allowable

since they recite similar features of claim 1, is not persuasive, since claim 1 has been

shown to be rejected.

13.   With respect to applicant's arguments that claims 3-6, 11, and 14-16 are

allowable since they depend directly or indirectly upon the independent claims 1, 7, and

12, are not persuasive, since claims 1, 7, and 12, have been shown to be rejected.
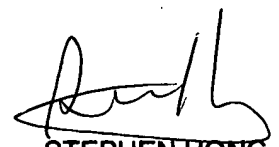
Conclusion

14.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wilson Tsui whose telephone number is (571)272-7596. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

W. T.   12/5/06

Wilson Tsui
Patent Examiner
Art Unit: 2178
December 5, 2006

STEPHEN HONG
SUPERVISORY PATENT EXAMINER